UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/994,410	11/27/2001	Carolynn Rae Johnson	PU010272	7497

7590 12/27/2005

JOSEPH S. TRIPOLI
THOMSON MULTIMEDIA LICENSING INC.
PATENT OPERATIONS
P.O. BOX 5312
PRINCETON, NJ 08543-5312

EXAMINER	
FLETCHER, JAMES A	
ART UNIT	**PAPER NUMBER**
2616	

DATE MAILED: 12/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/994,410	JOHNSON, CAROLYNN RAE	
	Examiner	Art Unit	
	James A. Fletcher	2616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *30 September 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *23-39* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *23-39* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 30 September 2005 have been fully considered but they are not persuasive.

In re page 5, Applicant's Representative states: "Instead of creating a second program list as taught and claimed in the Applicant's invention, in Ellis a Display screen 9616 provides a user with the ability to move a highlight window 9632 over a listing bar in recording listings 9618 and to select combine after option 9620 or combine before option 9622 for the recording identified in that listing bar."

The Examiner respectfully disagrees with the conclusion that the process described by Ellis et al does not create a second program list. The "combine before" or "combine after" functions shown on the screen in Fig 60, and referenced by the cited paragraphs in the office action, clearly indicate a listing of programs to be viewed.

While the Examiner believes the rejection stands on its own, there are further references to a creation of a second program list in the reference, as shown in Fig. 58, items 9578-9590. Therefore, Ellis et al clearly and distinctly disclose the feature of creating a second program list.

In re page 6, Applicant's Representative states: "in Ellis, a name is chosen for the combination and not for a second program list as taught and claimed by at least the Applicant's claim 23"

The Examiner respectfully disagrees. As analyzed and discussed above, the combination of programs created by either or both of the "combine" functions of Ellis et

al clearly creates a program list, which is clearly named as cited by the Applicant's Representative. Therefore, Ellis et al clearly and distinctly disclose the feature of providing a name for the second program list.

Further in re page 6, Applicant's Representative states: "in Ellis, a name chosen for the combination is added to the menu and not an identifier for a second program list as taught and claimed by at least the Applicant's claim 23."

The Examiner again respectfully disagrees. As analyzed and discussed above, the combination of programs is clearly disclosed as a second program list. Furthermore, Ellis et al clearly disclose a method of selecting the name chosen for that combination of programs. Therefore, Ellis et al clearly and distinctly disclose the feature of including an identifier as a selectable item of the menu.

In re pages 6 and 7, Applicant's Representative states: "in the invention of the Applicant, at least because of the taught and claimed second program list, a user is able to arrange any number of identified recorded programs in any order in the second program list for compilation and subsequent viewing in the arranged order."

The Examiner does not find any claim language in claim 23 or any other claim that mentions placing programs in the second list in any particular order, whether chosen by the user or performed automatically.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –

> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 23-26, 28-33, and 25-39 are rejected under 35 U.S.C. 102(e) as being anticipated by Ellis et al (US Patent Application Publication 2002/0174430).

Regarding claims 23 and 31, Ellis et al disclose a method and system for creating a video program list, comprising the steps of:

- presenting a menu including a first program list of recorded programs (Paragraph 0378 "Display screen 9616 may provide the user with the ability to move highlight window 9632 over a listing bar in recording listings 9618");
- identifying each of the recorded programs in the menu using a title that refers to at least one of a subject matter and an artistic content of the recorded programs (Paragraph 0378 "Display screen 9616 may provide the user with the ability to move highlight window 9632 over a listing bar in recording listings 9618");
- prompting a user to select at least one recorded program from the first program list to be included in a second program list (Paragraph 0378 "select

combine after option 9620 or combine before option 9622 for the recording identified in that listing bar");

- creating the second program list, including the at least one identified program (Paragraph 0378 "Pressing a remote control "OK" key will then cause the recording for that particular listing to be combined with currently selected recording");
- creating an identifier corresponding to the second program list (Paragraph 0378 "The combined recording may have the name of the originally selected program, the name of the program selected to be combined with it, the user may be able to choose which name to use, or the user may be allowed to enter a new name for the combination");
- including the identifier as a selectable item of the menu (Paragraph 0378 "The combined recording may have the name of the originally selected program, the name of the program selected to be combined with it, the user may be able to choose which name to use, or the user may be allowed to enter a new name for the combination").

Regarding claims 24 and 32, Ellis et al disclose a method and system of creating a video program list wherein the recorded programs are stored on multiple media (Paragraph 0205 "Recorded content icon 704 may permit users to distinguish between programs that are available for playback from a PVR and programs that will be airing in the future. Future programs may include VOD programs, PPV programs,

broadcast television programs, or other programming that is available through a source other than a PVR").

Regarding claim 25, Ellis et al disclose a method of creating a video program list wherein the programs are represented on the menu by means of a program title (Fig. 62).

Regarding claim 26, Ellis et al disclose a method of creating a video program list comprising the steps of:

- prompting the user to select an order for the programs comprising the second list (Fig. 63, items 9680 and 9682); and
- playing back the video programs comprising the second list in the selected order (paragraph 0205 "A program listing in listing bars 702 may include recorded content icon 704 that indicates that a recording for that listing is currently available for playback").

Regarding claim 30, Ellis et al disclose a system for generating a video recording and playback list, comprising the steps of:

- displaying a menu including a plurality of recorded programs (Paragraph 0378 "Display screen 9616 may provide the user with the ability to move highlight window 9632 over a listing bar in recording listings 9618");
- identifying each of the recorded programs in the menu using a title that refers to at least one of a subject matter and an artistic content of the recorded programs (Paragraph 0378 "Display screen 9616 may provide the user with

the ability to move highlight window 9632 over a listing bar in recording listings 9618");

- creating a list comprising user identified ones of the plurality of programs (Paragraph 0378 "Pressing a remote control "OK" key will then cause the recording for that particular listing to be combined with currently selected recording");
- modifying the menu to include the list as a user selectable item on the menu (Paragraph 0378 "The combined recording may have the name of the originally selected program, the name of the program selected to be combined with it, the user may be able to choose which name to use, or the user may be allowed to enter a new name for the combination").

Regarding claim 33, Ellis et al disclose a system for generating a video recording and playback list wherein the device is operable to allow a user to order the indicated items and wherein the processor is further programmed to playback the programs according to the order in response to user selection of the identifier (Fig 63, items 9680 and 9682).

Regarding claims 35 and 39, Ellis et al disclose a system for generating a video recording and playback list wherein the processor is further programmed to allow the user to specify the identifier (Fig. 64, item 9706).

Regarding claim 38, Ellis et al disclose a method for generating a video recording and playback list wherein the steps are accomplished without modifying video and audio program content of the indicated programs (Paragraph 0378 "If desired,

neither, either or both of the original recordings may be deleted when the combination is created." This clearly illustrates that the original programs remain after the combination is created).

Regarding claims 28-29, 36 and 37, Ellis et al disclose a system for generating a video recording and playback list wherein the first and second storage media are selected from the group comprising: optical disc media, magneto disc media, digital tape media, analog tape media, and hard disc drive [HDD] (Paragraph 004 "In one known system, a PVR may use an MPEG encoder to digitize broadcast television and then store the digitized broadcast television for later retrieval on a hard disk drive" and Paragraph 0171 "Recording equipment 204 may include PVR 208, VCR 210, or any other suitable recording device").

4. Claims 27 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ellis et al as applied to claims above, and further in view of Okada (6,181,870).

Regarding claims 27 and 34, Ellis et al suggest a system for transferring a playback list to a second storage medium (paragraph 0172 "Data link 209 may be used to transfer audio/video signals for programs between PVR 208 and VCR 210"), but do not specifically disclose doing so in response to a single user selection of the identifier.

Okada et al teach a system where a user defined chain is transferred from one medium to a second medium in response to a single user selection of the identifier (Col 93, line 62 - Col 94, line 2 "the editing multi-stage control unit 26 instructs the title reproduction control unit 23 to reproduce the VOBs in accordance with the PGC, out of the user-defined PGCs, that has been indicated by the user" and Col 93, lines 13-16

"the user-defined PGC information table that includes the new user-defined PGC generated in the PGC information table work are 21` is transferred to the RTRW management file work area").

As suggested by Ellis et al and taught by Okada, the copying of an edited program to a second medium provides a secure copy of the finished product, and products that perform the function are well-known, widely used, and commercially available.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Ellis et al in order to provide a command to transfer a play list to a second medium.

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James A. Fletcher whose telephone number is (571) 272-7377. The examiner can normally be reached on 7:45-5:45 M-Th, first Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Groody can be reached on (571) 272-7950. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JAF
20 December 2005

James J. Groody
Supervisory Patent Examiner
Art Unit 262 2616